

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-16 and 18-23 are pending, with claims 1, 20, and 23 being the independent claims. Claims 1-16 and 18-23 are sought to be amended. Applicants reserve the right to prosecute similar or broader claims, with respect to the cancelled and amended claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Examiner Interview

Applicants wish to thank Examiner Bartley for the telephonic interview conducted on July 3, 2008. Pursuant to the Interview Summary mailed July 14, 2008, which directs Applicants to file a statement of substance of the interview within one (1) month from the mailing date of the Interview Summary, Applicants submit herewith such a statement.

During the interview, Applicants' representative discussed with the Examiner a proposed amendment of claim 1. Examiner agreed to perform a search based on the proposed amended claim 1. Thus, Applicants agree with the substance of the Interview Summary.

Rejection under 35 U.S.C. § 112 First Paragraph

Claims 1-19 and 23 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Although Applicants believe the previously pending claims were in full compliance with all sections of 35 U.S.C., in order to expedite prosecution Applicants have clarified claims 1 and 23

Based on the amendments above, Applicants respectfully request the reconsideration and withdrawal of the rejection.

Rejections under 35 U.S.C. § 112 Second Paragraph

Claims 1-23 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter.

Although Applicants believe the previously pending claims were in full compliance with all sections of 35 U.S.C., in order to expedite prosecution Applicants have clarified claims 1, 3, 11, 20, and 23.

Based on the amendments above, Applicants respectfully request the reconsideration and withdrawal of the rejection.

Rejections under 35 U.S.C. § 103

Claims 1 - 10, 14, 15, and 18 - 23

In the Office Action the Examiner rejected claims 1-10, 14, 15, and 18 - 23 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,790,785 to Klug

("Klug") in view of an American Express web page reprinted from archive.org hyperlink labeled December 14, 2001 ("the Web page"). Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claims 1, 20, and 23 recite features that distinguish over the applied references. For example, claim 1 recites, in part, using "instructions to detect, based on the plurality of submitted fields, that there is an indication that the customer is an existing account holder" and "instructions to transmit a second account application to the customer, ***based on successful detection*** that there is an indication that the customer is an existing account holder." (Emphasis added). Also, for example claims 20 and 23 recite using respective language, in part, "***detecting*** that there is an indication that the customer is an existing account holder based on a selection of the selectable indicator associated with the first account application" and "transmitting a second account application to the customer, ***based on successful detection*** that there is an indication that the customer is an existing account holder." (Emphasis added).

Klug teaches a processing system whereby a user may store registration information in which, as the Examiner states in paragraph 15 of the Office Action, the "user determines whether to supply basic information ... or to supply expanded information." Therefore, Klug discloses a process where the user makes the determination concerning the amount of information to supply. In contrast, claims 1, 20, and 23 recite a method or system for "***detecting*** based on the plurality of submitted fields, that there is an indication that the customer is an existing account holder" and then transmitting "a second account application to the customer, ***based on successful***

detection that there is an indication that the customer is an existing account holder."

Klug does not teach at least the above-recited features of claims 1, 20, and 23.

Furthermore, the Web page does not overcome the deficiencies of Klug. On page 12 of the Office Action, the Examiner states, which Applicants do not acquiesce, that the Web page "teaches application forms for Internet users where the application is for a credit card account to a financial institution." Thus, the Web page is not used to teach or suggest, nor does it teach or suggest, at least the above-recited distinguishing features of claims 1, 20, and 23. Therefore, the applied references cannot be used to establish a *prima facie* case of obviousness for the pending claims.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 20, and 23, and find these claims allowable over the applied references. Also, at least based on their respective dependencies to claims 1 and 20, claims 2-16, 18, 19, 21, and 22 should be found allowable over the applied references, as well as for their additional distinguishing features.

Claims 11 - 13, and 16

In the Office Action the Examiner rejected claims 11 - 13 and 16 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,790,785 to Klug ("Klug") in view of the Web page, and in further view of the Examiner's Official Notice. Applicants respectfully traverse this rejection.

Claims 11-13 and 16, which ultimately depend from independent claim 1, are also patentable over the applied references for reasons similar to those set forth above

with respect to claim 1, and further in view of their own respective distinguishing features.

Also, Applicants respectfully assert that the Examiner has inappropriately taken “Official Notice” because according to the M.P.E.P. at Section 2144.03(A) (emphasis added):

Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known.***

In this same Section, the M.P.E.P. then provides some examples of when “official notice” was deemed appropriate:

In *Ahlert*, the court held that the Board properly took judicial notice that “it is old to adjust intensity of a flame in accordance with the heat requirement.” See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took “judicial notice of the fact that tape recorders commonly erase tape automatically when new ‘audio information’ is recorded on a tape which already has a recording on it”). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence.

Applicants assert that the features recited in the claims do not fit within one of the narrow exceptions noted by this Section of the M.P.E.P. This Section of the M.P.E.P. also states “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art

without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697.” Applicants therefore assert that it was inappropriate for the Examiner to take “Official Notice” of without providing documentary evidence.

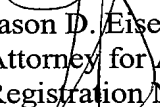
Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Jason D. Eisenberg
Attorney for Applicants
Registration No. 43,447

Date: 8/13/08
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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